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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/771,226 | 01/26/2001 | William Franklin Harris | B-0103.28 | 6933 |

7590

06/25/2002

LAW OFFICES OF CHRISTOPHER L. MAKAY
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EXAMINER

TUCKER, PHILIP C

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 06/25/2002

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

771226

Applicant(s)

HARRIS

Examiner

P. TUCKER

Group Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1 - 98 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1, 3-6, 9-11, 13-15, 20, 21, 26, 27, 32, 33, 49-54, 57-60, 62, 63, 76, 78-81, 84-86, 88-91, 93-98 is/are allowed.

☒ Claim(s) 2, 7, 8, 12, 16-19, 22-25, 28-31, 34-48, 55, 56, 61, 64-75, 77, 82, 83, 87, 92 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

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DETAILED ACTION

1. There was no claim 83, and 2 claims numbered 85. As such claim 84 has been renumbered as claim 83, and the first claim 85 has been renumbered as claim 84 under Rule 1.126.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2, 7, 8, 12, 16-19, 22-25, 28-31, 34-48, 55, 56, 61, 64-75, 77, 82, 83, 87 and 92 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 2, 12, 39-48, 56, 64-75, 77 and 78, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claims 7, 8, 17, 18, 23, 24, 29, 30, 35, 36, 38, 45, 55, 61, 66, 72, 82, 83, 92, the term "including" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

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Claims 2, 12, 56, 67, 77 and 87 contain the trademark/trade name Carbopol. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a polymer and, accordingly, the identification/description is indefinite.

Claims 7, 17, 23, 29, 35, 45, 55, 61, 66, 72, 82 and 92 teach "their functional equivalent" without teaching the nature or structure of such equivalents. Without further definition, the scope of such equivalents is not clear. Dependent claims fall herewith.

IN claims 16, 17, 19, 22, 23, 25, 28, 29, 31, 34, 35, 37, 55 and 66 there is no antecedent basis for "the polyalkylene glycol". The claims teach both polyethylene and polypropylene glycol, while the parent claim is limited to polyethylene glycol. Dependent claims fall herewith.


4. Claims 1, 3-6, 9-11, 13-15, 20, 21, 26, 27, 32, 33, 49-54, 57-60, 62, 63, 76, 78-81, 84-86, 88-91, 93-98 are allowable over the art of record.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. Is 703-872-9311.

PCT-2494

June 21, 2002


PHILIP C. TUCKER
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